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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/862,542	05/22/2001	Robert Alan Reeves	STEV-109	1268

7590 05/13/2004  
ROBERT E. STRAUSS  
74527 Moss Rose Drive  
Palm Desert, CA 92260

EXAMINER

CHANG, VICTOR S

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 05/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/862,542

Applicant(s)

REEVES ET AL.

Examiner

Victor S Chang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 02 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1,2,6-8 and 16-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 6-8 and 16-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. The Examiner has carefully considered Applicant's declaration, amendments and remarks filed on 2/2/2004. Applicant's amendment to claim 1 has been entered. However, it should be noted that the parenthetical expressions following the claim numbers are not compliant with the revised amendment practice 37 CFR 1.121. For example, in claim 1, the expression "(fourth amendment)" should be changed to -- (currently amended)--; and in claim 2, the expression "(previously amended)" should be changed to --(previously presented)--. Appropriate correction is required in Applicant's next communication.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Rejections not maintained are withdrawn. In particular, Applicant's argument that "direct-image" is inherent in the preamble limitation (Remarks, page 5, top paragraph) is persuasive. As such, the "new matter" issue over the phrase "direct-image" has been overcome.

### ***Claim Rejections - 35 USC § 112***

4. Claims 1, 2, 6-8 and 16-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The Examiner notes that since the last five lines of the newly amended claim 1 ("all said successive coats ...") appears to be a de facto open-ended "comprising" type clause, and it renders the scope of the current amendment to claim 1 at line 8 (replacing "comprising" to --consisting essentially of--) vague, indefinite and meaningless. Appropriate correction and/or clarification are required, i.e., all the structural elements within the "consisting essentially of" clause must be clearly recited. For the purpose of this Office action, absent a clear indication of what the basic and novel characteristics actually are, "consisting essentially of" will be construed as equivalent to "comprising." See MPEP § 2111.03.

#### ***Response to Amendment***

5. Claims 1-2, 6-8 and 16-19 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Markar et al. (US 5908694), substantially for the reasons set forth in section 4 of Paper No. 112403, together with the following additional observations.

Since the newly amended claim 1 is still being considered as a "comprising" claim, as set forth above, the Examiner notes that Applicant's arguments concerning the need to eliminate the lacquer layer (Remarks, page 5, second paragraph, and throughout) fail to exclude the additional structure of Makar, and Makar still teaches the invention as claimed.

Regarding the comparative experimental results presented in Mr. Stevenson's Declaration that Makar's transfer label lacks permanency, and the instant invention

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fused entirely into the surface of the polyethylene part with a smooth polished surface, the Examiner notes that while Mr. Stevenson's Declaration is persuasive, the instantly claimed invention fails to be patentably distinct, as set forth above.

6. Finally, as already pointed out in the first sentence of the Advisory action dated 2/25/2004, the Examiner notes that once the aforementioned issue of the scope of the claimed invention is corrected and clarified, this application appears to be allowable in view of Mr. Stevenson's Declaration.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor S Chang whose telephone number is 571-272-1474. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel H Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DANIEL ZIRKER  
PRIMARY EXAMINER  
GROUP 1300

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*Daniel Zinker*